

**REMARKS**

Claims 36 to 39, 40, 43 and 49 are canceled without prejudice, and therefore claims 1, 2, and 21 to 35, 41, 42 and 44 to 48 are pending and considered in the present application (since claims 3 to 20 were previously withdrawn in response to a restriction requirement and later canceled).

In view of the following, it is respectfully submitted that the presently pending and considered claims are allowable, and reconsideration is respectfully requested.

*The Office Action did not include any prior art rejections of claims 40, 41 or 44.*

As to the objection to claim 36, while the objection may not be agreed with, to facilitate matters, claim 36 has been canceled without prejudice. Therefore, withdrawal of the objection is respectfully requested.

As to the objections to claims 37 to 41, 43 and 44, while the objections may not be agreed with, to facilitate matters, claims 37 to 39, 40 and 43 have been canceled without prejudice, and claims 41 and 44 have been rewritten herein to so as to obviate the objections. Claim 40 is included in claim 1. Withdrawal of the objections is therefore respectfully requested.

Claims 36 and 42 to 49 were rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite.

While the objections may not be agreed with, to facilitate matters, claims 36 and 49 have been canceled without prejudice, and claim 42 has been rewritten so as to obviate the objections. Therefore, withdrawal of the objections is respectfully requested.

Claims 1, 2, 21 to 33, 42, 45 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 839,349 ("Volz") in view of German Published Application No. 100 18 143 ("Massler I") and the Background Information (at page 2, lines 20 to 34).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28

U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Although the rejections may not be agreed with (and regardless of the proper characterization of the Background Information), to facilitate matters, claim 1 has been rewritten to include the feature of claim 40 (which is canceled without prejudice) in which a layer thickness of the three layers together is approximately 0.5 micrometers to 4 micrometers at a micro-hardness of approximately 4 to 40 GPa.

*The Office Action did not include any prior art rejections of claims 40, 41 or 44.*

Any review of Massler and Volz, whether taken alone or combined, readily confirms that the applied references do not disclose or even suggest the above-discussed feature of claim 1.

Accordingly, claim 1, as presented, is allowable, as are its dependent claims. Withdrawal of the rejections is therefore respectfully requested.

Claims 34 to 36 and 47 to 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Volz in view of Massler I as applied to claims 1 and 45 above, and further in view of U.S. Patent No. 5, 577,896 (“Harada”).

Claims 36 and 49 are canceled without prejudice. Claims 34, 35, 47 and 48 depend from claim 1, and are therefore allowable for the same reasons, since the Harada reference does not cure – and is not asserted to cure -- the deficiencies of Volz and Massler as to claim 1, as presented. Withdrawal of the obviousness rejections is therefore respectfully requested.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Accordingly, claims 1, 2, and 21 to 35, 40 to 42 and 44 to 48 are allowable.

### **CONCLUSION**

It is therefore respectfully submitted that all of the presently pending and considered claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.


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Respectfully submitted,

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